

Appl. No. : 09/706,382
Filed : November 6, 2000

REMARKS

Reconsideration and allowance of this patent, as amended herein, is respectfully requested. By way of summary, Claims 1-20, 23 and 24 were previously pending in the application. Claims 1, 4, 9-11 and 13-18 have been amended herein. As a result, Claims 1-20, 23 and 24 remain pending in this application, as amended above. The Applicant respectfully submits that this application as amended is in a condition for allowance, and requests allowance of all the pending claims. Each of the Examiner's reasons for rejection of the claims is discussed below.

Indefiniteness under 35 U.S.C. §112, Second Paragraph

The Examiner has rejected Claims 1-20, 23 and 24 as being indefinite under 35 U.S.C. §112, second paragraph. In order to address the issues presented by the Examiner, the claims have been amended as described above. In particular, the phrase "corneal scleral tissue" has been replaced in Claim 1 with "scleral tissue", and appropriate antecedent basis for "laser beam", "predetermined pattern", and "treated area" have been placed within the amended claim set. The other matters of form raised by the Examiner have also been addressed by the included amendments. Based on these corrections, the Applicant believes that the claims are now fully compliant with the second paragraph of §112, and respectfully requests that the Examiner withdraw the §112 rejection from the pending claims as amended herein.

Obviousness-type Double Patenting Rejection

The Examiner has rejected Claims 1-20, 23 and 24 as being unpatentable over the claims of U.S. Patent No. 6,258,082 and U.S. Patent No. 6,263,879 to the same Applicant for reason of "obviousness-type" double patenting. The Applicant notes that the claims have been amended in the pending application. In addition, the Applicant notes that the two patents cited by the Examiner are currently both subject to both reexamination and reissue and that the claims have been amended in both of these cases as they are currently pending. Additionally, the claims in these cases are still subject to further revision during the reexamination and reissue process.

In light of the amendments made herein, as well as the status of the cited patents, the Applicant submits that the pending claims of the instant application are now distinct from the claims of the cited patents. In addition, because the claims in cited against the pending case are themselves pending, the Applicant also suggests that the obviousness-type double-patenting rejection should be merely a *provisional* rejection. In the event that the claims of these cases are

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found to be not patentably distinct from the claims of the currently pending case, the Applicant will file a terminal disclaimer to overcome the rejection.

Based on the pending nature of the claims in the cited patents, the Applicant therefore respectfully requests that the Examiner withdraw the obviousness-type double-patenting rejection from Claims 1-20, 23 and 24.

Rejections under 35 U.S.C. §103

The Examiner has rejected Claims 1-5, 7, 8, 14-20, 23 and 24 under 35 U.S.C. §103 as being unpatentable over U.S. Patent 5,520,679 to Lin in view of U.S. Patent 5,489,299 Schachar. The Examiner has rejected Claim 6 as being unpatentable over Lin in view of Schachar and in view of U.S. Patent 5,741,247 to Roszoiu. The Examiner has rejected Claims 9-12 as being unpatentable over Lin in view of Schachar and U.S. Patent 5,599,341 to Mathis et al. Finally, the Examiner has rejected Claim 13 as being unpatentable over Lin in view of Schachar, Mathis, and in view of U.S. Patent 5,845,024 to Tsushima et al. The Applicant respectfully traverses these rejections as applied to the amended claims in this patent.

In each of these rejections under 35 U.S.C. §103, the Examiner has rejected the claims at least in part over Lin in view of Schachar. In these rejections, the Examiner has used the Lin reference to provide support for teachings associated with specific laser parameters that can be used in the treatment of the eye, while relying upon the Schachar reference for the teaching that expansion of the sclera can be used to treat presbyopia. However, the Applicant notes that the amended claims, all of which are dependent from amended Claim 1, include elements which are not found in the combination of any of the cited references.

As the Examiner notes, Schachar discloses various treatment methods for presbyopia relating to expansion of the sclera. However, as amended, all of the pending claims include elements which are neither taught nor suggested by the cited references. In particular, the Applicant notes that as amended, Claim 1 recites: "controlling said fiber delivery unit to deliver said laser beam in a predetermined pattern onto a plurality of positions on the sclera surface to remove a portion of the sclera tissue outside the limbus area by ablating the sclera to a depth of 400-700 microns, whereby a presbyopic patient's vision is corrected to see near by increasing the accommodation of the eye." These limitations are not taught in Schachar, Lin, or any of the other references cited by the Examiner in the Office Action. For example, no suggestion is made in any of the references as to the appropriate depth of the ablation in any of the cited references.

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Therefore, the Applicant suggests that the combination of the cited references does not render Claim 1 of the pending case unpatentable under 35 U.S.C. §103. Because Claim 1 provides elements not found or suggested by the cited prior art references, the Applicant respectfully requests that the Examiner withdraw the rejection of Claim 1 as amended herein, and pass the claim to allowance. Claims 2-20, 23 and 24, all of which depend from Claim 1, include additional limitations that further define over the cited references. On this basis, as well as on the basis of the patentability of Claim 1, the Applicant requests that Claims 20-20, 23 and 24 be passed to allowance, and the §103 rejection withdrawn from these claims as well.

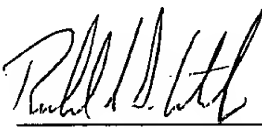
CONCLUSION

In light of the foregoing, the Applicant submits that pending Claims 1-20, 23 and 24 are allowable, and respectfully requests issuance of a Notice of Allowance by the Examiner. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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